

REMARKS

Status of the claims:

Claims 1-25 are pending and ready for further action on the merits. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 USC §102

Claims 1, 3, 4, 6, 13, 15-17, 19, 20, 22, 23, and 25 are rejected under 35 USC §102(b) as being anticipated by Brust '019 (US Patent No. 6,100,019).

Applicants traverse.

Applicants respectfully point out that the instant invention has the following characteristic features in claim 1

(a) variation coefficient of equivalent-circle diameter (COV of ECD) is 30% or less, and

(b) 70% or more of the total projected area of the silver halide grains meet:

(i) AgBrClI tabular grain having (111) faces as main planes,

(ii) Epitaxial portion junctioned to at least one apex portion, and

(iii) At least one dislocation line in an epitaxial portion.

The emulsion of the present invention has very low dispersity or very high uniformity, which results in high sensitivity, good storagability, and good processability (please see page 3, line 12 to page 4, line 3 of the instant invention).

Brust '019 does not disclose item (a) and item (b) (iii) discussed above. Thus, because Brust '019 does not disclose the elements of the instant invention, Brust '019 cannot anticipate the instant invention.

In particular, the Examiner's attention is directed to column 14, lines 18-26, column 15, lines 36-43, column 16, lines 28-35, column 16, lines 38-63, column 17, lines 15-18 and column 17, lines 33-37 of Brust '019. Brust '019 merely describes the average grain ECD (equivalent-circle diameter). The above-cited sections of Brust '019 reveal that 84%, 72%, and 75% of the tabular grain population exhibits high chloride epitaxy on 4 or more of the grain corners. Brust '019 fails to disclose or suggest the coefficient of variation of ECD as is claimed in the instant invention. For this reason alone, the rejection over Brust '019 is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Moreover, in example C, it is disclosed that the largest ratio (60%) of the grains have one or more dislocations of the epitaxial junction, which is lower than the 70% recited in item (b) mentioned above. Please see column 14, lines 23-25 in Brust

'019. In addition, the percentage of the dislocation is based on the number of epitaxials, not based on the total projected area as recited in item (b).

Thus, because Brust '019 fails to disclose all of the elements of the instantly claimed invention, Brust '019 cannot anticipate the instant invention. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §103

Claims 7 and 9 are rejected under 35 USC §103(a) as being unpatentable over Brust '019 in view of Antoniades '403 (US Patent No. 5,250,403).

Applicants traverse.

Brust '019 was discussed above in the above rejection. It was pointed out above that Brust '019 fails to disclose or suggest item (a) and item (b) (iii). Antoniades '403 also fails to disclose or suggest item (b) (iii). The only description in Antoniades '403 of dislocation is at column 7, lines 16-21, which states:

One of the discoveries that has contributed to the present invention is that tabular grain emulsion uniformity is enhanced by precipitating in one reaction vessel silver bromide grain nuclei that are crystallographically regular (i.e., internally free of defects such as twin planes or screw dislocations)

This passage, in effect, teaches away from the instant invention because it teaches away from the use of dislocation lines for the preparation of a uniform emulsion. Thus, one of ordinary skill in the art who combines the teachings of Brust '019 and Antoniades '403, would still fail to arrive at the instant invention. Moreover, the motivation for combining Brust '019 and Antoniades '403 is lacking. In other words, Applicants assert that the Examiner has failed to make out a *prima facie* case of obviousness with regard to the 35 USC §103(a) rejection over Brust '019 in view of Antoniades '403. Three criteria must be met to make out a *prima facie* case of obviousness.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP §2142 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). In particular, the Examiner has failed to meet the third element to make a *prima facie* obviousness rejection. Neither Brust '019 nor Antoniades '403 disclose or suggest (b) (iii) as discussed above. Thus, the instantly rejected claims (i.e., claims 7 and 9, which are dependent from claim 1) cannot be rendered obvious

by Brust '019 and Antoniades '403. The rejection is inapposite. For this reason alone, withdrawal of the rejection is warranted and respectfully requested.

Moreover, even if a proper *prima facie* case of obviousness were presented using the combination of Brust '019 and Antoniades '403 (which Applicants do not concede), the present written description discloses the advantageous features that can be achieved by practicing the instantly claimed invention. In particular, the instant invention has good storagability and processability, which is attained by using the grains meeting item (b) (iii). See, in particular, Example 2, Table 5 (on page 117 of the written description) and Table 6 (page 120), which show storagability. Also please note Example 4, in which Emulsions a(1) to a(3) (please see page 163, line 26 to page 164, line 1 of the instant written description) are used (see Table 10 on page 183), which show enhanced processability. The advantages described in Antoniades '403 are related to sensitivity and image structure (e.g., granularity and sharpness), and thus, good storagability and development dependency are features that were not desired (and are thus unexpected) from the disclosures of Antoniades '403 and Brust '019.

Finally, Antoniades '403 also fails to disclose items b(i) and b(ii). The silver halide grain of Antoniades '403 is AgBrI

(column 4, line 12 and claim 1). Moreover, there is no disclosure in Antoniades '403 about epitaxial or epitaxial portions. Thus, one of ordinary skill in the art would never combine the teachings of Antoniades '403 and Brust '019. For the reasons discussed above, neither Antoniades '403 nor Brust '019 can render obvious the instant invention, used individually or together. Accordingly, the rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

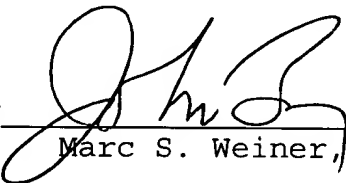
If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a response in connection with the present application. The required fee of \$950.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #32,881
Marc S. Weiner, #32,181

^{BS}
MSW/TBS/mua
0042-0455P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000